



S/N 09/091,704

PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: FRANKE Examiner: B. SHEWAREGED
Serial No.: 09/091,704 Group Art Unit: 1774
Filed: OCTOBER 13, 1998 Docket No.: 9663.40USWO
Title: A TRANSFER FOR DECORATING TEXTILES WITH COLORED
PATTERNS

CERTIFICATE UNDER 37 CFR 1.10

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I hereby certify that this paper or fee is being deposited with the United States Postal Service 'Express Mail Post Office To Addressee' service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

By: Omesh Singh
Name: Omesh Singh

RESPONSE

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed April 10, 2001, Applicant elects Group II, claims 15, 18-26, 67 and 68, with traverse. The non-elected claims may form the subject of a divisional application that would be entitled to the benefit of the filing date of the present application under 35 U.S.C. 121.

Applicant disagrees with the Examiner's characterization of the special technical feature of the invention, as well as with the assertion that a contribution over the prior art is not defined. Each of independent claims 1 and 15 recite that the polymer layer has a plasticizing point that is above the application temperature of the transfer. As was argued in the Amendment and Response filed on January 19, 2001, Olsen (US 5,916,399) does not teach or suggest such a feature. Applicant maintains that position. There is a corresponding technical feature in each of claims 1 and 15 that define a contribution over the prior art, and claims 1 and 15 share unity of

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invention. Applicant does not imply that there are not other features in claims 1 and 15 that define contributions over the prior art as well.

Further, Applicant respectfully submits that requiring restriction at this stage of prosecution is improper as there is no burden on the Examiner in not requiring restriction. Applicant notes that independent claims to a transfer (claim 1) and a method of making the transfer (claim 15) have been present in this application from the very beginning and that these claims have been searched and examined throughout the rather extensive prosecution to date. Applicant further notes that an initial requirement for restriction was made in an office action mailed May 20, 1999 in which each of independent claims 1 and 15 were asserted to be part of a common group (Group I) having unity of invention.

Requiring restriction at this stage of prosecution would be inconsistent with the previous prosecution during which claims 1 and 15 were alleged to be unpatentable over the prior art, yet no allegation of lack of unity of invention concerning claims 1 and 15 was made. Further, requiring restriction at this stage of prosecution would unduly burden Applicant, while providing no benefit to the USPTO as the product and method of claims 1 and 15 have already been searched and examined, and have been the subject of extensive prosecution.

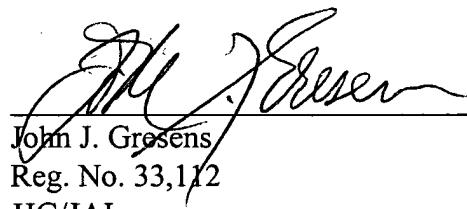
Withdrawal of the restriction requirement and examination of all claims is requested.

If any further questions arise, the Examiner is welcome to contact Applicants' representative at the number listed below.

Respectfully submitted,

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Date: Aug. 8, 2001


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